



IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Andrew M. SPENCER et al.

Confirmation No.: 4492

Application No.: 09/996,720

Examiner: C. Chace

Filing Date: 11/30/2001

Group Art Unit: 2189

Title: METHOD TO STORE AND RETRIEVE MEMORY CARD USAGE INFORMATION

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on August 29, 2005.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

() (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

() one month	\$120.00
() two months	\$450.00
() three months	\$1020.00
() four months	\$1590.00

() The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$500.00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,

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Atty. Dkt. No. 10014185-1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant: Andrew M. Spencer, et al.
Title: METHOD TO STORE AND RETRIEVE MEMORY CARD USAGE
INFORMATION
Appl. No.: 09/996,720
Filing Date: 11/30/2001
Examiner: C. CHACE
Art Unit: 2189

BRIEF ON APPEAL

Mail Stop Appeal Brief - Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Under the provisions of 37 C.F.R. § 41.37, this Appeal Brief is being filed together with a Transmittal authorizing the amount of \$500.00 covering the Rule 41.20(b)(2) appeal fee to be charged to Deposit Account 08-2025. If this fee is deemed to be insufficient, authorization is hereby given to charge any deficiency (or credit any balance) to the deposit account 08-2025.

1. REAL PARTY IN INTEREST

The real party in interest is the assignee of record, Hewlett-Packard Development Company L.P.

2. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

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3. STATUS OF CLAIMS

Claims 1-6, 8, 9, 12-14, 16-18, 20-27 and 30-33 are pending in the application. Claims 7, 10-11, 15, 19 and 28-29 are cancelled. Claims 1-6, 8, 9, 12-14, 16-18, 20-27 and 30-33 are rejected and are the subject of this appeal.

4. STATUS OF AMENDMENTS

The present application is under a final rejection (See Final Rejection mailed June 27, 2005). Appeal of claims 1-6, 8, 9, 12-14, 16-18, 20-27 and 30-33 is appropriate because all of the claims have been twice rejected. See 35 U.S.C. § 134(a). There are no amendments after final rejection.

5. SUMMARY OF CLAIMED SUBJECT MATTER

The following provides a concise explanation of the subject matter defined in each of the claims involved in the appeal, referring to the specification by page and line number and to the drawings by reference characters, as required by 37 C.F.R. § 41.37(c)(1)(v). Each element of the claims is identified by a corresponding reference to the specification and drawings where applicable. Note that the citation to passages in the specification and drawings for each claim element does not imply that the limitations from the specification and drawings should be read into the corresponding claim element.

The invention of independent claim 1 is directed to a method for storing memory card usage information on a memory card. The method comprises collecting information about usage of the memory card using a processor (See step 10 of Fig. 1, p. 4, paragraph [0021], lines 7-9). The specification provides a number of examples of usage of a memory card, such as power-on events, write events, and read events (See p. 4, paragraph [0021], lines 2-7). The specification also distinguishes memory card usage information from other information such as customerID or resellerID information (See p. 8, paragraph [0032]). The information about usage of the memory card is recorded in an area of the memory card (See step 20 of Fig. 1, pp. 6-7, paragraph [0026]). The information about usage of the memory card is accessed from the memory card (See step 30 of Fig. 1, p. 1, paragraph [0003], pp. 7-8, paragraph [0029]). The information about the usage of the memory card is displayed on a display of the memory card (See pp. 7-8, paragraph [0029]).

The invention of independent claim 14 is directed to a data structure in a memory card. The data structure comprises a computer readable storage containing at least one event descriptor about the usage of the memory card (See p. 3, paragraph [0016]). For each event descriptor there is a count representing the number of occurrences of that event (See p. 3, paragraph [0016]). For each of the event descriptors, there is provided an amount of memory used by an aggregation of events corresponding to the event descriptor (See pp. 4-5, paragraph [0021]).

The invention of independent claim 16 is directed to a system for storing memory card usage information on a memory card. The memory card comprises a number of components including: (1) an area of memory of the memory card for recording information about usage of the memory card (See step 20 of Fig. 1, pp. 6-7, paragraph [0026]), (2) a processor for collecting the information about usage of the memory card for accessing the information about usage of the memory card from the memory card (See steps 10 and 30 of Fig. 1, p. 1, paragraph [0003], p. 4, paragraph [0021], lines 7-9, pp. 7-8, paragraph [0029]); and (3) a display on the memory card for displaying information about usage of the memory card (See pp. 7-8, paragraph [0029]).

The invention of independent claim 17 is directed to a method. The method comprises collecting information about usage of a portable memory card in an electronic device using a processor (See step 10 of Fig. 1, p. 4, paragraph [0021], lines 7-9), recording the information about usage of the memory card on the memory card itself (See step 20 of Fig. 1, pp. 6-7, paragraph [0026]), and displaying the information about usage of the memory card on a display of the memory card (See pp. 7-8, paragraph [0029]).

The invention of independent claim 23 is directed to a method. The method comprises a number of steps including (1) providing a portable memory card, (2) monitoring usage of the memory card using a processor (See step 10 of Fig. 1, p. 4, paragraph [0021], lines 4-8), (3) storing the usage of the memory card in an area of memory on the memory card (See step 20 of Fig. 1, pp. 6-7, paragraph [0026]), and (4) displaying the usage of the memory card on a display on the memory card (See pp. 7-8, paragraph [0029]).

The invention of independent claim 30 is directed to a method for storing memory card usage information on a memory card comprising a number of steps including (1) collecting information about usage of the memory card using a processor (See step 10 of Fig. 1, p. 4, paragraph [0021], lines 7-9), (2) recording the information about usage of the memory card in an area of memory of the memory card (See step 20 of Fig. 1, pp. 6-7, paragraph [0026]), and (3) accessing, using a processor, the information about usage of the memory card from the memory card (See step 30 of Fig. 1, p. 1, paragraph [0003], pp. 7-8, paragraph [0029]), wherein the information about usage of the memory card comprises at least one of a measurement of how full the memory card is and the number of times data was corrected by the memory card (See p. 4, paragraph [0021], lines 22-25).

The invention of independent claim 32 is directed to a system for storing memory card usage information on a memory card comprising a number of components including (1) an area of memory of the memory card for recording information about usage of the memory card (See step 20 of Fig. 1, pp. 6-7, paragraph [0026], p. 3, paragraph [0018]), and (2) a processor for collecting information about usage of the memory card and for accessing the information about usage of the memory card from the memory card (See steps 10 and 30 of Fig. 1, p. 1, paragraph [0003], p. 4, paragraph [0021], lines 7-9, pp. 7-8, paragraph [0029], p. 3, paragraph [0018]), wherein the information about usage of the memory card comprises at least one of a measurement of how full the memory card is and the number of times data was corrected by the memory card (See p. 4, paragraph [0021], lines 22-25).

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be reviewed on appeal are:

- A. the rejection of claims 14, 30 and 32 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,000,006 to Bruce et al. (hereafter “Bruce”);
- B. the rejection of claim 14 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication 2002/0107832 to Shimizu et al. (hereafter “Shimizu”);
- C. the rejection of claims 23-26 and 30-33 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,478,679 to Himoto et al. (hereafter “Himoto”);

D. the rejection of claims 1-6, 8-9, 12-13, 16-17, 23 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Bruce;

E. the rejection of claims 1-6, 8-9, 12-13, 16-17 and 20-22 under 35 U.S.C. § 103(a) as being unpatentable over Shimizu;

F. the rejection of claims 20-22 and 24-25 under 35 U.S.C. § 103(a) as being unpatentable over Bruce;

G. the rejection of claim 18 under 35 U.S.C. § 103(a) as being unpatentable over Shimizu and Bruce, each taken separately, in view of U.S. Patent No. 5,532,689 to Bueno (hereafter "Bueno"); and

H. the rejection of claim 27 under 35 U.S.C. § 103(a) as being unpatentable over Himoto and Bruce, each taken separately, in view of U.S. Patent No. 6,587,140 to No (hereafter "No").

7. **ARGUMENT**

The claims do not stand or fall together. Instead, Applicants present separate arguments for various independent and dependent claims. Each of these arguments is separately argued below and presented with separate headings and sub-heading as required by 37 C.F.R. § 41.37(c)(1)(vii).

Drawing objections

As an initial matter, and to the extent that the outstanding objection to the drawings (See Final Office Action on page 3) need be addressed in this appeal, appellants submit the following as argued in the Amendment and Reply filed on April 19, 2005.

The drawings were objected to under 37 CFR 1.83(a). Specifically, the Final Office Action stated that all of the limitations of claims 2-16, 18, and 20-33 must be shown or the feature(s) cancelled from the claims(s). Appellants submit that no further drawings or drawing amendments are required in the present application.

For example, with respect to the method claims 2-13, 18-28, and 30-31, the steps recited therein are further definitions of the steps already shown in the flow chart of Figure 1.

Thus, these steps are shown in the drawings. The specific description of these steps is also fully supported by the specification.

With respect to claims 16, 29, 32 and 33, these claims are directed to an embodiment of the invention directed to a system with components that implement the steps of Figure 1, as these steps are further defined. The specific description of these implemented steps is also fully supported by the specification.

Moreover, applicants note that 35 U.S.C. 113 requires a drawing only “where necessary for the understanding of the subject matter to be patented.” In the present case, an understanding of the subject matter to be patented, as embodied in the claims, is clear from Figure 1 in its current form along with the specification. Thus, no further drawings, or drawing amendments are required.

Still further, appellants submit that there is no requirement that the exact wording of the claims be reproduced in the figures, as long as the invention as claimed can be understood from the disclosure. It is well known in U.S. patent practice, such as in the chemical arts for example, that many claimed inventions require no drawings whatsoever. In the present case, no further drawing or drawing amendments are required to understand the invention. To require that “all of the limitations” of claims 2-16, 18, and 20-33 be expressly shown in detail in the drawing would amount to an unnecessary and burdensome requirement that much of the text of the specification be transposed to the drawings. Such an amendment is not necessary for the present application, where the claims can be well understood without.

For at least the above reasons, appellants request that the objection to the drawings be withdrawn.

A. The rejection of claims 14, 30 and 32 under 35 U.S.C. § 102(b) as being anticipated by Bruce

1. Claim 14

Independent claim 14 recites “wherein for each of a plurality of event descriptors an amount of memory used by an aggregation of events corresponding to respective each of the event descriptors.” Bruce fails to suggest at least this feature of claim 14. With respect to this feature, the Final Office Action on page 6 cites to element 44 of Figure 6 of Bruce.

Element 44 of Bruce, however, is a physical block address (See col. 6, lines 60-65), not an amount of memory. While a block address may correspond to a region in memory, it is not itself an amount of memory. Thus, Bruce fails to anticipate or render obvious independent claim 14.

2. Claims 30 and 32

Independent claims 30 and 32, respectively recite “accessing, using a processor, the information about usage of the memory card from the memory card, wherein the information about usage of the memory card comprises at least one of a measurement of how full the memory card is and the number of times data was corrected by the memory card”, and “a processor for collecting information about usage of the memory card and for accessing the information about usage of the memory card from the area of memory of the memory card, wherein the information about usage of the memory card comprises at least one of a measurement of how full the memory card is and the number of times data was corrected by the memory card.” Bruce fails to disclose or suggest at least these features of claims 30 and 32. With respect to these features the Final Office Action on page 7 cites to Bruce in column 5, lines 5-12, and states “[t]his effectively keeps track of the number of times data was corrected by preventing it from having to be corrected.” The cited section of Bruce, however, fails to disclose the number of times data was corrected on a memory card. The fact that Bruce may suggest preventing data from having to be corrected is not a disclosure of accessing information regarding a number of times data is corrected from any memory card. Thus, Bruce fails to anticipate or render obvious independent claims 30 or 32.

B. The rejection of claim 14 under 35 U.S.C. § 102(b) as being anticipated by Shimizu

Independent claim 14 is directed to a data structure in a memory card. The data structure comprises computer readable storage containing at least one event descriptor about the usage of the memory card, and for each event descriptor a count representing the number of occurrences of that event. Shimizu fails to disclose a computer readable storage containing at least one event descriptor about the usage of the memory card. Thus, claim 14 is patentable over Shimizu.

Shimizu does not disclose information about usage of a memory card in the manner recited in the claims.

All of the independent claims, including claim 14, require steps or components for performing steps regarding information or event descriptors about usage of a memory card. For example, the data structure of claim 14 comprises computer readable storage containing at least one event descriptor about the usage of the memory card, and for each event descriptor a count representing the number of occurrences of that event. Shimizu fails to disclose a computer readable storage containing at least one event descriptor about the usage of the memory card as in claim 14.

With respect to the feature relating to usage of the memory card, the Final Office Action on page 8, states with respect to claim 14: “The storage containing at least one event descriptor about the usage of the memory card is disclosed in figure 4 as advertisement usage information”, and on page 15 with respect to claim 1: “Recording the information about usage of the memory card in an area of the memory card is disclosed in paragraph 61 [of Shimizu] as the generated use condition information and the billing information being recorded in the control information storage unit 726.” Appellants submit, however, that Shimizu fails to suggest storing any information about usage of a memory card in a memory card, in figure 4, paragraph 61 or in any other portion of Shimizu.

Shimizu discloses in Fig. 4 advertisement usage information such as second content identifier, and user identifier, and further discloses in paragraph 61 recording generated use condition information and billing information in a control information storage unit 726 of a website, where the use condition information includes period of rent, number of times reproduction of the DVD is possible, and whether or not copying is allowed.

Shimizu, however, fails to disclose recording or storing information about the usage of a memory card in figure 4, paragraph 61, or anywhere else in Shimizu. With respect to figure 4, the advertisement usage information cannot reasonably be interpreted as usage of a memory card, whether or not that information is stored on the memory card. Likewise with respect to paragraph 61, the number of times a website has been accessed (which is also shown in figure 4) cannot reasonably be interpreted as the usage of a memory card, whether or not the number of times is stored on the memory card, since it represents usage of the web

site and is unrelated to any usage of the memory card. Moreover, the generated use condition information and billing information disclosed in paragraph 61 is directed to rental of a DVD (See Shimizu, paragraph 61), and also cannot be reasonably interpreted as usage of a memory card. For example, the number of times the reproduction is possible concerns reproduction of a DVD, not the usage of a memory card.

The Examiner's interpretation of information about usage of a memory card is not reasonable.

Appellants maintain (and have maintained throughout the prosecution of the present application) that the Examiner's interpretation of information about usage of a memory card (or event descriptors about usage of a memory card) in the claims is not a reasonable interpretation of the claims. Claims under examination are to be given a broad reasonable interpretation consistent with the specification. In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000) (emphasis added). The claim interpretation must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 15 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). The interpretation by the Examiner is not consistent with the plain language of the claims, the specification, or file history of the present application, or the interpretation of those skilled in the art. If the claims are reasonably interpreted, the rejections based on Shimizu must fail.

The interpretation of the limitation of "information about usage of the memory card" to include a record of information concerning the use of rented DVDs not contained on the memory card, or the number of times a website has been accessed as disclosed in Shimizu is not a reasonable interpretation of that limitation. This interpretation is not consistent with the plain language of claim 1, the specification, or the file history of the present application.

In Shimizu, information concerning the use of rented DVDs is just that, information about the use of DVDs. This information is not about the usage or any other aspect of a memory card, even if that information about the use of DVDs happens to be stored on a memory card. The mere fact that general information is stored on a memory card does not make it information about the use of the memory card. This interpretation by the Examiner would essentially require that any information that is stored on a memory card be information

about the use of the memory card merely because a memory card may act to store the information.

In sum, the plain meaning of “information about the usage of a memory card”, the specification, and the file history all make clear that general information is not information about the usage of a memory card merely because that information happens to be stored on a memory card. Thus, the interpretation of the limitation of “information about usage of the memory card” to include a record of information concerning the use of rented DVDs, or the number of times a website has been accessed as disclosed in Shimizu, is not a reasonable interpretation of that limitation.

C. The rejection of claims 23-26 and 30-33 under 35 U.S.C. § 102(e) as being anticipated by Himoto

1. Claims 23-26 of which claim 23 is independent

Independent claim 23 recites “monitoring usage of the memory card”, and “storing the usage of the memory card” in an area of memory on the memory card. With respect to the limitation “usage of the memory card”, the Examiner states on page 9 of the Final Office Action: “[the] examiner has interpreted ‘usage of the memory card’ as the type of games stored and the respective scores, for example, as shown in figure 7, 8A, and 8B [of Himoto], as they are activities stored on the card that are not used by the card.” Appellants respectfully disagree with this interpretation.

Himoto discloses a memory card 10 with an LCD 14 that displays information such as a game number and game scores (see Figures 7-8B). Himoto, however, does not disclose monitoring usage of the memory card, and storing the usage of the memory card in an area of memory on the memory card. The information displayed on the LCD 14 of Himoto, whether stored in the memory card 10 or not, cannot reasonably be interpreted as usage of the memory card for reasons analogous to those discussed above with respect to Shimizu.

In Himoto, information such as game number and game score is merely information about a game. This information is not about the usage of a memory card, even if that information concerning the game number and game score happens to be stored on a memory card. As discussed above with respect to Shimizu, the mere fact that general information is stored on a memory card does not make it information about the use of the memory card.

Moreover, the arguments with respect to the reasonableness of the Examiner's interpretation of the "usage of the memory card" apply equally well to the rejection based on Himoto.

In sum, Himoto fails to disclose or suggest features recited in claim 23, and claim 23 is patentable thereover for at least this reason.

Dependent claims 24-26 depend from claim 23, and are allowable for at least the same reasons, as well as for patentable features recited therein.

2. Claims 30-33 of which claims 30 and 32 are independent

Independent claims 30 and 32 recite, respectively, "recording the information about usage of the memory card in an area of memory of the memory card" and "an area of memory of the memory card for recording the information about usage of the memory card" in a similar fashion to 23, and are patentable for at least the reasons discussed above with respect to claim 23.

Moreover, claims 30 and 32 require that the information about usage of the memory card comprises at least one of a measurement of how full the memory card is and the number of times data was corrected by the memory card. This feature is also not disclosed by Himoto. The Final Office Action on page 10 alleges that Figures 5A-5E, 6A-6C and col. 10, lines 64-67 of Himoto disclose this feature. Appellants respectfully disagree. Figures 5A-5E and 6A-6C merely illustrate the address region in which a program is stored. Himoto, however, does not disclose that a measurement of how full is the memory is recorded in a memory card. Appellants submit that a stored program is not a measurement of how full a memory card merely because that program is stored in a memory between certain addresses of the memory card.

Claims 31 and 33 depend from claims 30 and 32, respectively, and are patentable for at least the same reasons as well as for further patentable features recite therein.

D. The rejection of claims 1-6, 8-9, 12-13, 16-17, 23 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Bruce

1. Claims 1, 3-6, 8-9, 12-13, 16-17 and 23 of which claims 1, 16, 17 and 23 are independent

Independent claim 1 recites “displaying the information about the usage of the memory card on a display on the memory card.” Bruce fails to disclose or suggest at least this feature of claim 1.

Bruce discloses a flash memory system in Fig. 4 including a cache 22, unified re-map table 20, and bus 32 to flash memories 24 and 26, where the flash memories may be flash-memory chips or cards of flash memory chips such as flash PC cards (Fig. 4, col. 6, lines 35-41). The unified re-map table 20 is contained in volatile SRAM memory, and a back-up copy 28 of the re-map table is stored in flash memory 26 (col. 6, lines 43-45).

In contrast to independent claim 1, however, Bruce does not disclose “displaying the information about the usage of the memory card on a display on the memory card.” Presuming for the sake of argument that the cards of flash memory chips such as the flash PC cards disclosed in Bruce could be considered to be memory cards (which they are not), Bruce does not suggest that such cards either have a display, or that any display on the cards display the information about usage of the cards. Thus Bruce fails to disclose all the limitations of claim 1.

The Final Office Action on page 12 appears to recognize that Bruce does not disclose “displaying the information about the usage of the memory card on a display on the memory card”, but argues that “it would have been obvious to one of ordinary skill in the art at the time of the invention . . . to keep track of how many times the memory has been written to, on a sticker on the flash memory.” Appellants respectfully submit, however, that a “sticker on a flash memory” is not a display as recited in claim 1, and further modifying Bruce as suggested by the Examiner would render the Bruce device unfit for its intended purpose.

A display on a memory card, as recited in claim 1, cannot be reasonably interpreted as a “sticker” on that card. Again, the Examiner has an unreasonably broadened interpretation of a term in the claims. When properly interpreted in light of the specification, the display of claim 1, precludes an interpretation as a “sticker.” Moreover, the Examiner’s interpretation on page 12 of the Office Action: “[d]isplaying the information about the usage of the memory card on a display on the memory is printed matter not functionally related to the memory card’s method of operation” misses the point. Claim 1 recites that information be displayed

on a display of the memory card. A display of a memory card is not mere printed matter, but a component of the memory card that may display information on the memory card.

Moreover, the Examiner's suggested modification of Bruce would render the Bruce device unfit for its intended purpose. The Examiner states on page 12 of the Final Office Action: "By simply writing on a sticker on the memory slash marks, e.g., one could keep track of how many times the memory has been written without having to add all of the circuitry, thereby reducing the manufacturing costs." Bruce discloses in its abstract that wear-leveling is performed when total and incremental write counts exceed system-wide totals and incremental thresholds. Removing the circuitry to store the write counts, as would occur according to the Examiner's suggested modification, would not allow for the wear-leveling to be performed in the Bruce device. Thus, the Examiner's suggested modification of Bruce would render the Bruce device unfit for its intended purpose.

Independent claims 16, 17 and 23 recite corresponding limitations to those discussed with respect to claim 1, and are thus patentable over Bruce for analogous reasons.

2. Claim 2

Claim 2 depends from claim 1, and thus the arguments with respect to claim 1 apply equally well to claim 2. Claim 2 is further patentable for at least the following reasons.

Claim 2 recites "wherein the collecting step comprises monitoring write events, read events and power-on events." This feature is neither disclosed nor suggested by Bruce. The Final Office Action states on page 13 with respect to monitoring and claim 2: "If power is applied, it is monitored." Monitoring a power-on event, however, requires more from a system than merely performing power on, and Bruce fails to disclose such monitoring.

3. Claim 26

Claim 26 depends from claim 23, and thus the arguments with respect to claim 23 apply equally well to claim 26. Claim 26 is further patentable for at least the following reasons.

Claim 26 recites "wherein monitoring usage comprises monitoring an amount of memory used on the memory card and monitoring an amount of memory remaining free on

the memory card.” This feature is neither disclosed nor suggested by Bruce. The Final Office Action on page 14 cites to column 10, lines 30-32 as disclosing this feature. Bruce in column 10, lines 30-32, however, merely discloses updating write counts, but does not suggest monitoring an amount of memory used or monitoring an amount of memory remaining free on the Bruce device.

E. The rejection of claims 1-6, 8-9, 12-13, 16-17 and 20-22 under 35 U.S.C. § 103(a) as being unpatentable over Shimizu

1. Claims 1, 3-6, 8-9, 12, 16-17 and 22 of which claims 1, 16 and 17 are independent

As discussed above with respect to claim 14, all of the independent claims, including claims 1, 16 and 17, require steps or components for performing steps regarding information or event descriptors about usage of a memory card, a feature that Shimizu does not disclose or suggest. Claims 1, 16 and 17 are patentable for at least this reason.

Moreover, with respect to Shimizu and independent claims 1, 16, and 17, Shimizu fails to disclose displaying information about the usage of a memory card on a display on the memory card. While Shimizu discloses an output apparatus 710 consisting of a number of components including a memory card (See paragraph [0047]), Shimizu does not disclose that the memory card has a display which displays information about the usage of the memory card. Moreover, Shimizu discloses that the output apparatus 710 consists of a monitor (See paragraph [0047]), so any information that is displayed would be displayed on the monitor, not the memory card.

The Final Office Action on page 15 appears to recognize that Shimizu does not disclose displaying the information about the usage of the memory card on a display on the memory card, but argues that “it would have been obvious to one of ordinary skill in the art at the time of the invention . . . to keep track of how many times the user can use the card to rent movies”, and to do so by writing slash marks on a sticker on the memory. For reasons similar to those provided above with respect to Bruce, Appellants respectively submit, that a sticker on the memory is not a display as recited in claims 1, 16 or 17 and further modifying Shimizu as suggested by the Examiner would render the Shimizu device unfit for its intended purpose.

The arguments above with regard to a display not being reasonably interpreted as a “sticker” apply equally well here. Thus, even if Shimizu were modified as suggested by the Examiner, the result would not meet the limitations of claim 1.

Moreover, the Examiner’s suggested modification of Shimizu is without proper motivation. The Examiner states on pages 15-16 of the Final Office Action: “By simply writing on a sticker on the memory slash marks, e.g., one could keep track of how many times the card has been used without having to add all of the circuitry, thereby reducing the manufacturing costs.” Shimizu, however, does not suggest keeping track of how many times its card has been used even with its circuitry, much less on any display. Moreover, removing its circuitry would render the Shimizu device unfit for its intended purpose.

Dependent claims 3-6, 8-9, 12 and 22 depend from one of independent claims 1 and 17, and are allowable for at least the same reasons, as well as for further patentable features recited therein.

2. Claim 2

Claim 2 depends from claim 1, and thus the arguments with respect to claim 1 apply equally well to claim 2. Claim 2 is further patentable for at least the following reasons.

Claim 2 recites “wherein the collecting step comprises monitoring write events, read events and power-on events.” This feature is neither disclosed nor suggested by Shimizu. The Final Office Action on page 16 cites to Figure 6 of Shimizu as disclosing the features of claim 2, and argues that the “monitoring” is inherently performed when write events, read events and power-on events are being performed stating: “By performing the transaction, the system must, inherently, be aware of it.” Monitoring a write, read or power-on event, however, requires more from a system than merely performing those steps, and Shimizu fails to disclose such monitoring.

3. Claim 13

Claim 13 depends from claim 1, and thus the arguments with respect to claim 1 apply equally well to claim 13. Claim 13 is further patentable for at least the following reasons.

Claim 13 recites “wherein the collecting step comprises changing a count associated with an event descriptor when the event occurs; and further comprising the steps of comparing the count to a threshold, and if the threshold is equaled or exceeded, then causing a message to be sent.” This feature is neither disclosed nor suggested by Shimizu. The Final Office Action on page 18 cites to paragraph 10 of Shimizu as disclosing this feature. The cited section of Shimizu, however, does not disclose any comparison of a count associated with an event descriptor to a threshold, such that if the threshold is equaled or exceeded, a message is sent. There is simply no comparison of an event descriptor count to a threshold disclosed in paragraph 10 of Shimizu.

4. Claim 20

Claim 20 depends from claim 17, and thus the arguments with respect to claim 17 apply equally well to claim 20. Claim 20 is further patentable for at least the following reasons.

Claim 20 recites “wherein collecting information further comprises counting a number of times an image file was written to the memory card.” This feature is neither disclosed nor suggested by Shimizu. The Final Office Action on page 20 cites to paragraph 2 and Figure 4 of Shimizu as disclosing this feature. While paragraph 2 refers to image data, neither paragraph 2 nor the information in Figure 4 suggest that the number of times that image data is written to a memory card is counted.

5. Claim 21

Claim 21 depends from claim 17, and thus the arguments with respect to claim 17 apply equally well to claim 21. Claim 21 is further patentable for at least the following reasons.

Claim 21 recites “wherein collecting information further comprises counting a number of times music files were written to the memory card.” This feature is neither disclosed nor suggested by Shimizu. The Final Office Action on page 20 cites to paragraph 2 and Figure 4 of Shimizu as disclosing this feature. While paragraph 2 refers to audio data, neither paragraph 2 nor the information in Figure 4 suggest that the number of times that audio data is written to a memory card is counted.

F. The rejection of claims 20-22 and 24-25 under 35 U.S.C. § 103(a) as being unpatentable over Bruce

1. Claims 20-21

Claims 20-21 depend from claims 17, and thus are patentable for at least the same reasons, as well as further patentable features recited therein.

With respect to the limitations of claims 20 and 21, the Final Office action states on page 22 that it is very well known in the art that music file and image files require writes. Appellants submit, however, that even if music files and image files require writes, the Examiner has provided no proper motivation as to why the stored information in the Bruce device should be music files or image files. Thus, the obviousness rejection based on Bruce must fail.

2. Claim 22

Claim 22 depends from claims 17, and thus is patentable for at least the same reasons, as well as further patentable features recited therein.

Claim 22 recites “wherein collecting information further comprises tracking a number of times the memory card is formatted.” With respect to the limitations of claim 22, the Final Office action states on page 22 that it is very well known in the art that formatting files require writes. Appellants submit, however, that even if formatting files require writes, the Examiner has provided no proper motivation as to why any formats should be tracked in the Bruce device. Thus, the obviousness rejection based on Bruce must fail.

3. Claims 24-25

Claims 24-25 depend from claim 23, and thus are patentable for at least the same reasons, as well as further patentable features recited therein.

With respect to the limitations of claims 24 and 25, the Final Office action states on page 21 that a display being a window or screen is known. Appellants submit, however, that even if window or screen displays are known, one skilled in the art would not modify the Bruce device to include a display for reasons discussed above. Namely, as noted above, and presuming for the sake of argument that the cards of flash memory chips such as flash PC cards disclosed in Bruce could be considered to be memory cards (which they are not), Bruce does not suggest that such cards either have a display, or that any display on the cards display the information about usage of the cards. Thus, there is no motivation for one skilled in the art to have included either a window display or a screen display on the flash PC card of Bruce. Thus, the obviousness rejection based on Bruce must fail.

- G. The rejection of claim 18 under 35 U.S.C. § 103(a) as being unpatentable over Shimizu or Bruce, each taken separately, in view of Bueno

Claim 18

Claim 18 depends from claim 17. As discussed above, neither Shimizu nor Bruce disclose or suggest the limitations as recited in claim 17. Bueno was cited for allegedly disclosing counting the number of times a memory card is inserted into an electronic device,

but fails to cure the deficiencies of Shimizu or Bruce. Thus, claim 18 is patentable over Shimizu, Bruce and Bueno.

H. The rejection of claim 27 under 35 U.S.C. § 103(a) as being unpatentable over Himoto or Bruce, each taken separately, in view of No

Claim 27

Claim 27 depends from claim 23. As discussed above, neither Himoto nor Bruce disclose or suggest the limitations as recited in claim 23. but fails to cure the deficiencies of Himoto or Bruce. No was cited for allegedly disclosing a memory card for use in a digital camera, but fails to cure the deficiencies of Himoto or Bruce. Thus, claim 27 is patentable over Himoto, Bruce and No.

8. CONCLUSION

For the foregoing reasons, it is submitted that the PTO's rejections are erroneous, and reversal of the applied rejections is respectfully requested.

Respectfully submitted,

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CLAIMS APPENDIX

1. (Previously Presented) A method for storing memory card usage information on a memory card, comprising:

collecting information about usage of the memory card using a processor;

recording the information about usage of the memory card in an area of memory of the memory card;

accessing the information about usage of the memory card from the area of memory of the memory card using a processor; and

displaying the information about the usage of the memory card on a display on the memory card.

2. (Original) The method as defined in claim 1, wherein the collecting step comprises monitoring write events, read events and power-on events.

3. (Original) The method as defined in claim 1, wherein the collecting step comprises changing a count associated with an event descriptor when the event occurs.

4. (Previously Presented) The method as defined in claim 3, wherein the collecting step further comprises storing a value parameter associated with said event descriptor when the event occurs.

5. (Previously Presented) The method as defined in claim 3, wherein the collecting step comprises changing a running total associated with said event descriptor when the event occurs.

6. (Original) The method as defined in claim 1, wherein the recording step comprises recording the information about usage in a dedicated area in said memory card.

7. (Canceled)

8. (Previously Presented) The method as defined in claim 1, wherein the collecting step comprises changing a count associated with an event description when the

event occurs; and wherein the accessing step comprises displaying the count on the display on the memory card.

9. (Previously Presented) The method as defined in claim 1, wherein there are a plurality of event descriptors; and wherein said accessing step comprises displaying a plurality of the event descriptors on the display on the memory card, wherein each of the displayed plurality of events descriptors is selectable, so that on selection, additional usage information will be displayed that is associated with that selected event descriptor.

10-11. (Canceled)

12. (Previously Presented) The method as defined in claim 1, further comprising the step of creating write and read commands allowing a host to store the information about usage and read that information.

13. (Original) The method as defined in claim 1, wherein the collecting step comprises changing a count associated with an event descriptor when the event occurs; and further comprising the steps of comparing the count to a threshold, and if the threshold is equaled or exceeded, then causing a message to be sent.

14. (Previously Presented) A data structure in a memory card, comprising, computer readable storage containing at least one event descriptor about the usage of the memory card, and for each event descriptor a count representing the number of occurrences of that event, wherein for each of a plurality of event descriptors an amount of memory used by an aggregation of events corresponding to respective each of the event descriptors is provided.

15. (Canceled)

16. (Previously Presented) A system for storing memory card usage information on a memory card, comprising:

an area of memory of the memory card for recording information about usage of the memory card ;

processor for collecting the information about usage of the memory card for accessing the information about usage of the memory card from the memory card; and

a display on the memory card for displaying the information about the usage of the memory card.

17. (Previously Presented) A method, comprising:

collecting information about usage of a portable memory card in an electronic device using a processor;

recording the information about usage of the memory card in an area of memory on the memory card itself; and

displaying the information about the usage of the memory card on a display on the memory card.

18. (Previously Presented) The method of claim 17 wherein collecting information further comprises counting physical insertions of the memory card into the electronic device.

19. (Cancelled)

20. (Previously Presented) The method of claim 17 wherein collecting information further comprises counting a number of times an image file was written to the memory card.

21. (Previously Presented) The method of claim 17 wherein collecting information further comprises counting a number of times music files were written to the memory card.

22. (Previously Presented) The method of claim 17 wherein collecting information further comprises tracking a number of times the memory card is formatted.

23. (Previously Presented) A method, comprising:

providing a portable memory card;

monitoring usage of the memory card using a processor;

storing the usage of the memory card in an area of memory on the memory card; and

displaying the usage of the memory card on a display on the memory card.

24. (Previously Presented) The method of claim 23 wherein displaying the usage further comprises displaying the usage on a window on the memory card.

25. (Previously Presented) The method of claim 23 wherein displaying the usage further comprises displaying the usage on a screen on the memory card.

26. (Previously Presented) The method of claim 23 wherein monitoring usage comprises monitoring an amount of memory used on the memory card and monitoring an amount of memory remaining free on the memory card.

27. (Previously Presented) The method of claim 23 wherein providing a portable memory card further comprises providing the portable memory card in a digital camera.

28 -29. (Canceled)

30. (Previously Presented) A method for storing memory card usage information on a memory card, comprising:

collecting information about usage of the memory card using a processor;

recording the information about usage of the memory card in an area of memory of the memory card; and

accessing, using a processor, the information about usage of the memory card from the memory card, wherein the information about usage of the memory card comprises at least one of a measurement of how full the memory card is and the number of times data was corrected by the memory card.

31. (Previously Presented) The method of claim 30, wherein the information about usage of the memory card comprises a measurement of how full the memory card is.

32. (Previously Presented) A system for storing memory card usage information on a memory card, comprising:

an area of memory of the memory card for recording information about usage of the memory card; and

a processor for collecting information about usage of the memory card and for accessing the information about usage of the memory card from the area of memory of the memory card, wherein the information about usage of the memory card comprises at least one of a measurement of how full the memory card is and the number of times data was corrected by the memory card.

33. (Previously Presented) The system of claim 32, wherein the information about usage of the memory card comprises a measurement of how full the memory card is.

9. **EVIDENCE APPENDIX**

None.

10. RELATED PROCEEDINGS APPENDIX

None.